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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/568,540	02/17/2006	Kentarou Kanae	285648US0PCT	2976
22850	7590	11/06/2008		
OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314				
EXAMINER				
MESH, GENNADIY				
ART UNIT		PAPER NUMBER		
1796				
NOTIFICATION DATE		DELIVERY MODE		
11/06/2008		ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary

Application No.

10/568,540

Applicant(s)

KANAE ET AL.

Examiner

GENNADIY MESH

Art Unit

1796

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 October 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 11-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 11-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-946)
- 3) ☐ Information Disclosure Statement(s) (PTO/SG/US)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

Applicant's amendment filed on October 14, 2008 is acknowledged.

Applicant cancelled all previously rejected claims and filed new Claims 11-18.

Note, that claimed subject matter claimed by new Claims 11-18 has not been changed. Therefore, rejection is maintained as it was set forth in previous Office action mailed on April 14, 2008.

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

1. Claims 11 -18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Finerman et al.(US 6,288,171) in view of Sone et al.(US 6,255,416).

Finerman discloses thermoplastic elastomer composition as thermoplastic vulcanizates and articles from this composition (see column 10, lines 15-20), comprising crystalline polypropylene and at least one conjugated diene based polymer (see column 1, lines 30 – 68).

Note, that Finerman does not disclose catalytic system for production of conjugated diene based polymer, but rather open to any polymers (homo- or copolymers) of conjugated diene monomers.

However, Sone teach that conjugated diene based polymers, obtained by specific catalytic system, comprising a rare earth element as neodymium (see column

4, lines 40-50) could have narrow molecular weight distribution, resulting to improved mechanical properties, processability and wear resistance.

Therefore, it would be obvious to one of ordinary skill to use conjugated diene based polymers, obtained per teaching of Sone in the composition disclosed by Finerman in order to improve improved mechanical properties, processability and wear resistance of the composition.

Regarding limitations related to catalyst as it claimed in Claim 11 and 12 – see Sone column 2, lines 45 – 68 and column 3, lines 1-35 and see column 4, lines 40-50.

Regarding limitations of Claims 13 and 14 – see Sone, column 8, line 38 and column 3, lines 5-10.

Regarding Claims 15-16 see Finerman: column 10, lines 3-14 and column 1, lines 65-68 and column 2, lines 1-2.

Regarding limitation of Claim 17 see Finerman: column 9, lines 50 – 64.

Response to Arguments

2. Applicant's arguments filed October 14, 2008 have been fully considered but they are not persuasive.

Applicant's arguments related to Claims 11 -18 rejected under 35 U.S.C. 103(a) as being unpatentable over Finerman et al. (US 6,288,171) in view of Sone et al. (US 6,255,416) based on following;

i) Applicant argue that Sone fails to teach all catalyst components claimed by Claim 11, specifically Sone fails to teach limitation (d). Note, that Applicant did not provide any support for this statement. However, as it was stated in previous Office

action mailed on April 14, 2008 Sone disclosed all catalyst components including component specified by limitation (d) of Claim 1 - see column 3, line 1 -35, specifically line 34.

Therefore, this Applicant argument was found unpersuasive.

ii) Applicant also argue that claimed composition provide unexpected benefits as excellent of compression compare with composition disclosed by Finerman.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., compression set) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Also note, that is substantially same, composition disclosed by Finerman in view of Sone will have substantially same properties, including compression set.

Therefore, this Applicant argument also was found unpersuasive.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to GENNADIY MESH whose telephone number is (571)272-2901. The examiner can normally be reached on 10 a.m - 6 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on (571) 272 1119. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Gennadiy Mesh
Examiner
Art Unit 1796

/GM/

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/Vasu Jagannathan/

Supervisory Patent Examiner, Art Unit 1796